

REMARKS

Claims 1-39 are pending. Applicants elect with traverse Group 1 (claims 1-17 and 20-22) drawn to non-human transgenic animals and cells therefrom, which have altered melusin expression, for examination on the merits. With regard to the requirement for elections of species, 1(a) altered melusin expression due to stable expression, (i) modification of melusin expression at transcriptional level (e.g., genetic approach of knocking out the melusin genes), and mouse of 129SV strain are elected. Claims 1-17 and 20-22 of Group 1 read on at least one of the elected species. Therefore, claims 1-17 and 20-22 are generic. Applicants reserve the right to prosecute nonelected subject matter in a further patent application.

It appears that the Examiner inadvertently omitted claim 22 from the restriction requirement. If Group 1 does not include claims 1-17 and 20-22 as it apparently should, Applicants request that a corrected Action be issued listing claim 22 in one of the 13 groups so a fully informed election can be made.

With respect to the Examiner's requirement for elections of species, Applicants have elected 1(a)(i) such that the elected claims read on non-human transgenic animals that have altered melusin expression due to an inactivation of melusin gene by homologous recombination (see claim 5-6) and cells derivable from the non-human transgenic animal. Claim 1 of elected Group 1 is generic for the species (a)-(b), (i)-(iii), and 129SV strain. While an election of species is proper, no restriction requirement can be made upon an indication that a generic claim is allowable. With respect to all of the elected species, claims 1-17 and 20-22 are generic and therefore restriction with respect to the species is improper.

The amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry. The breadth of the claims is not changed because claim amendments are directed to correcting "use" claims to methods of using products of the claims. The amendments do not further limit the originally intended scope of protection.

Notwithstanding the above election, reconsideration of the restriction requirement is requested because examination of all pending claims would not constitute an undue burden. In particular, as stated on page 3 of the Action, at least claims of the first recited

process of manufacture (i.e., claims 24-25 of Group 4) and the first recited process of use (i.e., claims 18 and 23 of Group 2) should be examined in this application in accordance with 37 CFR § 1.499.

Moreover, Applicants disagree with the allegation in the Action that the pending claims lack unity of invention, and therefore belong to different groups of inventions. Traversal is based on the pending claims being so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, Applicants request that the pending claims be examined together in this application. Here, the special technical feature is a non-human transgenic animal having altered melusin expression (see claim 1).

Applicants submit that, in accordance with the M.P.E.P., the claims identified by the Examiner as Groups 1 to 8 are linked to form a single general inventive concept. In particular, the Examiner's attention is directed to M.P.E.P. § 1850(III)(A). Combinations of Different Categories of Claims (8th Ed., Rev. 3, August 2005) which states at 1800-97 to 1800-98:

The method for determining unity of invention under Rule 13 PCT shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product . . .

[A] process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

It was alleged in the Action that the inventions listed by the Examiner as Groups 1 to 8 do not relate to a single general inventive concept because they lack the same or corresponding special technical features under PCT Rule 13.2. But here, the special technical feature linking the pending claims is a non-human transgenic animal having altered melusin expression. In accordance with the section of the M.P.E.P. quoted above claims 1-17, 20-22, and 26 are directed to the product; claims 24-25 are directed to a process "specially adapted" for the product's manufacture; and claims 18-19, 23,

27-29 are directed to a use of the product. Accordingly, Applicants submit that there is no lack of unity with regard to claims 1-29.

If the present requirement is not withdrawn, such that claims 1-29 are searched and examined in this application, the Examiner is respectfully requested to address with particularity why M.P.E.P. § 1850(III)(A). does not apply to this application.


Furthermore, it is noted that claim 1 is a generic or linking claim and that examination should proceed under the provisions of M.P.E.P. § 809. Under the Notice dated March 26, 1996 (1184 OG 86) implementing the Federal Circuit's decisions of *In re Ochiai*, 37 USPQ2d 1127 (1995) and *In re Brouwer*, 37 USPQ2d 1663 (1996), Applicants request rejoinder of process claims upon an indication that a product claim is allowable.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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